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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,011	11/01/2001	Roy K. Greenberg	PA-5270-RFB	3255

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EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,011

Applicant(s)

GREENBERG ET AL.

Examiner

P dro Philogene

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,5,6, rejected under 35 U.S.C. 102(b) as being anticipated by Neuss Malte (DE 4,115,136).

With respect to claim 1, Malte discloses a medical grasping device comprising: an elongate control member (1) having an atraumatic distal tip section and a proximal end portion; as best seen in Fig.4, the elongate control member further including a grasping portion (4) proximal the distal tip section; an outer sheath (9) with a passageway therethrough, as best seen in FIG.4, surrounding the elongate control member and relatively movable with respect thereto; and a control assembly (10,11,12) disposed at a proximal end of the outer sheath and the proximal end portion of the elongate control member; as best seen in FIG.4, and in operative relation thereto for urging the grasping portion from a distal end of the outer sheath and retraction thereinto; as best seen in FIG.4.

With respect to claims 4-6, Malte discloses all the limitations, as best seen in FIGS 1-8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuss Malte (DE 4,115,136) in view of Fearnot et al. (472,368).

With respect to claims 2,3, it noted that Malte did not teach of a an elongated control member defining a lumen extending through into which a guide wire is receivable and movable with respect therethrough; as claimed by applicant. However, in a similar art, Fearnot et al evidence the use of a an elongated member defining a lumen into which a guide wire is receivable and movable to facilitate the insertion of the shaft and grasping device.

Therefore, given the teaching of Fearnot et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Malte, as taught by Fearnot et al to provide an elongate member with a guide wire to facilitate insertion of the shaft and the grasping device

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuss Malte (DE 4,115,136) in view of Avellanet (6,264,664).

With respect to claim 7, it is noted that Malte teaches all the limitations, except for a connecting block affixed to the control member disposed in a longitudinal slot; as claimed by applicant. However, in a similar art, Avellanet evidences the use of a

connecting block disposed in a slot to move the grasping device in and out of the sheath.

Therefore, given the teaching of Avellanet, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the connecting block and the slot in the device of Avellanet with the control assembly of the device of Malte to facilitate the in and out of the grasping device within the sheath.

Claims 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuss Malte (DE 4,115,136) in view of Hillstead (5,098,440).

With respect to claims 8-21, it is noted that Malte teaches all the limitations, except for wire loops that are substantially circular upon full deployment, as claimed by applicant. However, in a similar art, Hillstead evidences the use of wire loops that are circular upon full deployment and having side sections that overlap and touch the vessel wall to engage the object to be retrieved with a greater force.

Therefore, given the teaching of Hillstead, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate the design of the grasping device of Hillstead in the grasping device of Malte to engage the object to be retrieved with a greater force.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuss Malte (DE 4,115,136) in view of Fearnot et al. (472,368) in view of Hillstead (5,098,440).

With respect to claim 22, the above combination of references teaches all the limitations, as set forth above.

Response to Amendment

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of this new rejection.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
February 16, 2004


PEDRO PHILOGENE
PRIMARY EXAMINER